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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,531	11/28/2000	James F. Young	10271-021-999	7010

20583 7590 02/09/2005

JONES DAY  
222 EAST 41ST ST  
NEW YORK, NY 10017

EXAMINER

CHEN, STACY BROWN

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/724,531

Applicant(s)

YOUNG ET AL.

Examiner

Stacy B Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) See Continuation Sheet is/are allowed. allowable. spc 2/4/05.
- 6) ☒ Claim(s) 3, 180, 182 and 308 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**Continuation of Disposition of Claims:** Claims pending in the application are 1,3,5,179-184,186,187,189,192,193,195,201,204-212,222-227,231-233,241,242,244,245,250,280-299 and 303-308.

**Continuation of Disposition of Claims:** Claims allowable are 1,5,179,181,183,184,186,187,189,192,193,195,201,204-212,222-227,231-233,241,242,244,245,250,280-299 and 303-307.

### **DETAILED ACTION**

1. Applicant's amendment and response filed December 2, 2004 is acknowledged and entered. Claims 1, 3, 5, 179-184, 186, 187, 189, 192, 193, 195, 201, 204-212, 222-227, 231-233, 241, 242, 244, 245, 250, 280-299 and 303-308 are pending. Claim 308 is now rejoined with the other elected claims because Applicant amended the claims to read on elected subject matter. In view of this amendment, a new rejection is made over claim 308, see below.
2. The Office acknowledges the requested courtesy copies of the statements by co-inventors Jeffry D. Watkins and Herren Wu. All the requirements for Correction of Inventorship under CFR 1.48(a) have been met.
3. The rejection of claims 3, 5, 281 and 283 under 35 U.S.C. 101 is withdrawn in view of Applicant's amendment inserting the term, "isolated" before "antibody". The rejection of claims 261-263, 276, 284 and 287 under 35 U.S.C. 112, second paragraph, is withdrawn in view of Applicant's amendments and persuasive arguments.

### ***Double Patenting***

4. The rejection of claim 180 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of US Patent 6,656,467, is maintained for reasons of record.

The provisional rejection of claims 3, 180 and 182 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 153-158 of copending application USSN 09/996,288 is no longer a provisional rejection because USSN 09/996,288 has issued as US Patent 6,818,216. Therefore, claims 3, 180 and 182 are rejected under the

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judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 55-58 of US Patent 6,818,216.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 308 is rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US Patent 5,824,307). Claim 308 is drawn to an isolated antibody comprising a complementarity determining region (CDR) having an amino acid sequence of a variable light (VL) CDR of the antibody P12F2. The specification discloses that the VL CDRs of antibody P12F2 are SEQ ID NO: 21, 22 and 6 (Table 2). The prior art does not disclose an antibody having SEQ ID NO: 21 or 22, however, Johnson discloses palivizumab, which contains VL CDR3 having SEQ ID NO: 6 (see Johnson SEQ ID NO: 34, amino acids 88-96, and instant specification Table 2, “SYNAGIS®”). Johnson’s antibody is a humanized monoclonal antibody that binds the RSV F protein (Johnson, column 2, lines 20-21). Therefore, Johnson anticipates the antibody claimed in claim 308.

***Conclusion***

6. Claims 1, 5, 179, 181, 183, 184, 186, 187, 189, 192, 193, 195, 201, 204-212, 222-227, 231-233, 241, 242, 244, 245, 250, 280-299 and 303-307. Claims 3, 180, 182 and 308 are

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rejected. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).


Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy B. Chen whose telephone number is 571-272-0896. The examiner can normally be reached on M-F (7:00-4:30). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James C. Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

  
Stacy B. Chen  
February 4, 2005

  
2/7/05  
JAMES HOUSEL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600